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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,327	07/10/2001	David E. Zeidler	GIC-628	8459

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LAW OFFICE OF BARRY R LIPSITZ
755 MAIN STREET
MONROE, CT 06468

EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/902,327

Applicant(s)
Zeidler et al.

Examiner
Boccio, Vincent

Art Unit
2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jul 1, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 & 4 6) ☐ Other:

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2615.

Claim Objections

1. Claims 2-4, 11, 13 objected to because of the following informalities:
{A} Claim 2, line 4; claim 4, line 3; claim 11, line 4; claim 13, line 3, all recite, "said EPG", without initially introducing the limitation, therefore the examiner requires an amendment to change "said" to "a" or "an", to add additional clarity to the claims.

Please review all claims 1-56, for similar occurrences
Appropriate correction is required.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, all the limitations, as claimed in the claims such as:

- {1} claim 2 etc., "EPG";
- {2} claim 27, "ATVEF";
- {3} providing program notifiers and the responding to them(Method flow charts);
- {4} not to record reruns;
- {5} the user interface to activate/de-activate;
- {6} claim 7 etc..., "lapsing recording, past identified end";
- {7} "VCR Plus Codes";
- {8} "commercial";
- {9} claim 29, "non-program content stored separately", for example etc.....,

all features claimed are required to be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
4. Claims 1-3, 5-6, 8-9, 10-12, 14-15, 17-18, 47-48, 50-53, 55-56 are rejected under 35 U.S.C. 102(a) as being anticipated by Bodkin et al. (WO 01/11865).

Regarding claims 1-3, 5, 10-12, 14, 47-48, 52-52 Bodkin discloses and meets the limitations associated with a PVR, personal versatile recorder, comprising:

- o receiving at the PVR a plurality of TV signals (Fig. 2, "tuner 10 a & b"), which recording of one or more TV programs to recording unit 13;

controlling the recording pausing/suspending recording, for at least a portion of the time during the one or more TV programs (page 28, lines 13-15, "not to record advertisements during the recording", pausing and resuming recording with respect to advertisement breaks, or commercials etc.....), wherein the predetermined criteria comprises an EPG, electronic program guide information, which guides the recording to pause and resume recording operation around advertisements.

Regarding claims 6 and 15, Bodkin further discloses that the broadcaster provides the start and end signals for breaks (page 28, lines 3-4), and further discloses receiving compressed

digitally encoded video(page 9-10), etc., satellite(page 9),
therefore, a program identifier of a digital TV signal.

Regarding claims 8-9, 17-18, 50-51, 55-56, Bodkin further
meets the limitation of providing information to the PVR to
support the receiving and decoding of notifiers,
DTV/computer(page 12), in order to respond to the provided
notifiers, eliminating commercials, as Bodkin does.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs
of 35 U.S.C. 102 that form the basis for the rejections
under this section made in this Office action:
A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in
this or a foreign country or in public use or on sale in this country,
more than one year prior to the date of application for patent in the
United States.
6. Claims 19, 22, 23, 26 are rejected under 35 U.S.C. 102(b) as
being anticipated by Schindler et al.(US 5,995,155).

Regarding claims 19, 22, 23, 26, Schindler in Fig. 1,
discloses and meets the limitations associated with a method and
corresponding apparatus, meeting the limitation of:

enabling advanced recording options(col. 4, Fig. 13, "Record
1320") on a PVR system, the method comprising:

- o receiving PVC TV signals(Fig. 7, "524", cols. 2-3, 7-
8), being one of SET-TOP box, DTV, computer(Fig. 1);
- o recording TV programs
- o while preventing recording reruns based on EPG

data(col. 17, lines 57-, Fig. 13, "1310").

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodkin et al. (WO 01/11865) in view of Schindler (US 5,995,155).

Regarding claims 4 and 13, Bodkin fails to disclose suspending a recording event upon determining the recording is a rerun.

Schindler teaches in a video recording system when recording by series, keeping track of what has been recorded and avoiding duplicate recordings(col. 4, lines 15-20), as taught by Schindler et al.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to provide the feature of recording by series/titles, and to maintain a database of what

has been recorded, thereby the recording event is suspended when a rerun of a program is detected, wherein the predetermined criteria is electronic program guidance data to guide the recording system to not record reruns of already recorded movies, thereby utilizing the available space for different episodes only of a series recording mode, such as record by title/series.

9. Claims 7, 16, 49, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodkin et al. (WO 01/11865) in view of Knudson et al. (US 6,141,488).

Regarding claims 7, 16, 49, 54, Bodkin fails to disclose wherein the PVR waits a predetermined time after the program end time to receive or act on the program notifier, terminating recording at the first occur

- o lapsing of the predetermined amount of time and
- o receipt of the end of program notifier.

Knudson teaches in the prior art (Fig. 3), (or Fig. 5, utilizing one event only, as Fig. 5, deals with multi. sequential time events), in a program guide system, to not act upon the end of program based on a clock, to extend recording by a predetermine amount of time, such as 3 minutes, to provide a high level of assurance of the recording of the end of desired program recording events (col. 1, lines 50-65), as taught by Knudson et al..

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Bodkin by incorporating the feature of extending the recording event time or to terminate recording after lapsing of a predetermined amount of time, beyond the notified end time, as taught by Knudson.

10. Claims 27-28, 29, 30-31, 33-34, 36-38, 39, 40, 43-44, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodkin et al. (WO 01/11865) as applied to the claims above, in view of Barton (US 2001/0049820 A 1).

Regarding claims 27-28, 30-31, 33-34, 36-38, 40, 43-44, 46 Bodkin discloses and meets all limitations as claimed but, fails to disclose the utilization of ATVEF, triggers to facilitate the non-recording of non program content, such as commercials.

Barton, teaches and describes ATVEF having additional information to identify the commercial breaks (page 3, col. 1, lines 9-), as taught by Barton.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Bodkin by utilizing a standard such as ATVEF providing commercial break information to perform the recording events without commercials by pausing at commercials and resuming at the end of commercials as Bodkin does, as taught by Barton.

Regarding claims 29 and 39, Bodkin teaches, eliminating commercials segments by identifying, pausing and resuming.

Barton teaches, recording commercials and identifying their location(EPG data, electronic data identifying programs -vs- commercials), in the received video stream, thereafter recording on a medium with additional information identifying their locations, providing the commercials in the beginning of playback of the recording event,

wherein as claimed, during the suspension of providing the program segments, commercials are provided, recorded separately in their own recording areas of the record medium, as taught by Barton.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the combination by recording commercials in their own areas which are separate from the program record areas, as is inherent, due to no over lap between commercials and program segments, thereby providing the ability to provide commercial segments initially on playback of a record event, as taught by Barton.

11. Claims 32 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodkin et al.(WO 01/11865) and in view of Barton(US 2001/0049820 A 1), as applied to the claims above and further in view of Goldschmidt Iki et

al.(US 6,226,444).

Regarding claim 32 and 42, the combination, as applied fails to provide the user at the local system the ability to choose, to suspend or enable recording of, non program content.

Goldschmidt teaches, which is a PVR system(Fig. 1), recording desired shows thru an EPG(Fig. 5), wherein the user is provided with an enabling/disabling means to record or not record non-program or commercials, associated with a user interface for activating and deactivating, recording with/without commercials(Fig. 6), thereby providing a higher level of user control, with respect to recorded content, as taught by Goldschmidt,

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the combination by incorporating provide a user interface means to enabling or disabling recording of non-program content, as taught by Goldschmidt, providing a higher level of user control of the content to be recorded.

12. Claims 35 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodkin et al.(WO 01/11865) and in view of Barton(US 2001/0049820 A 1), as applied to the claims above and further in view of Knudson et al.
(US 6,141,488).

Regarding claims 35 and 45, the combination as applied fails to disclose the feature of wherein the PVR waits a predetermined time after the program end time to receive or act on the program notifier, terminating recording at the first occur

- o lapsing of the predetermined amount of time and
- o receipt of the end of program notifier.

Knudson teaches in the prior art (Fig. 3), (or Fig. 5, utilizing one event only, as Fig. 5, deals with multi. sequential time events), in a program guide system, to not act upon the end of program based on a clock, to extend recording by a predetermine amount of time, such as 3 minutes, to provide a high level of assurance of the recording of the end of desired program recording events (col. 1, lines 50-65), as taught by Knudson et al..

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the combination by incorporating the feature of extending the recording event time or to terminate recording after lapsing of a predetermined amount of time, beyond the notified end time, as taught by Knudson.

13. Claims 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schindler (US 5,995,155) in view of Bodkin et al. (WO 01/11865).

Regarding claims 20 and 24, Schindler provides a means to

not record reruns, by, maintaining a database of recorded series, with other data to identify the episode associated with the series, thereby avoiding duplicate recordings(col. 4, lines 3-25), but, Schindler fails to disclose, wherein this maintaining of a database to avoid duplicate recording, is associated with a head end, controlling the events to record or not to record reruns.

Bodkin teaches that a head end operators can supply signals to control recording operations from the head end, to the user premisses, thereby controlling recording of desired content(page 28), as taught by Bodkin, as is well known.

It would have been obvious to one skilled in the art at the time of the invention in view of Schindler and Bodkin, that it would have been further obvious,

to apply head end control in recording by providing directive code signals from the head end,

further that the head end, as head ends are well known to do, keep track of user activity, such as recorded shows, as Schindler does locally, and to allow recording by title/series, as Schindler teaches, and to provide the head end the ability upon performing a recording control service to control recording for users with the feature of means to eliminating duplication of requested title, duplicate episodes, at the user premisses, overseen by the head end, as suggested by the combination, to one

skilled in the art, with Schindler and Bodkin.

14. Claims 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schindler(US 5,995,155) in view of Goldschmidt Iki et al.(US 6,226,444).

Regarding claims 21 and 25, Schindler teaches a means to, not record reruns, by keeping track of recorded programs, but, fails particularly disclose the activation and deactivation of the feature.

The examiner cites, Goldschmidt, which is a PVR system(Fig. 1), recording desired shows thru an EPG(Fig. 5), wherein the user is provided with an enabling/disabling means, associated with a user interface for activating and deactivating, a recording feature, such as with/without commercials(Fig. 6), thereby providing a higher level of user control, with respect to recorded content, as taught by Goldschmidt, therefore, it would have been obvious to one skilled in the art at the time of the invention to provide enabling/disabling control of recorded content, allowing a user to control the desired content, to modify Schindler to provide a means to enabling/disabling means to record/not record, reruns, as Goldschmidt, teaches to provide a higher level of user control of the content to be recorded, as Goldschmidt does.

Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Contact Information

15. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vin
March 15, 2003


VINCENT BOCCIO
PRIMARY EXAMINER